

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application Number : 09/505,721 Confirmation No.: 7099  
Applicants : Joseph A. GIORDANO, et al.  
Filed : February 17, 2000  
Title : SYSTEM AND METHOD FOR PROCESSING FINANCIAL  
TRANSACTIONS  
TC/Art Unit : 3628  
Examiner: : Clement B. GRAHAM  
Docket No. : 24124.000132

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Sir

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over seven years ago on February 17, 2000. On December 2, 2003, an initial Office Action was issued, rejecting claims 1-50 under 35 U.S.C. § 101 as being allegedly unpatentable for being directed to non-statutory subject matter. On June 2, 2004, Applicants timely filed a responsive amendment to the Office Action, amending several claims and adding others to provide clarification, and argued against the rejection. On July 8, 2005, the Office found Applicants amendments/arguments persuasive and issued a new rejection based on alleged anticipation by U.S. 6,195,541 to Griffith et al. ("Griffith") under 35 U.S.C. § 102(e). Applicants timely filed a responsive amendment to the Office Action, amending several claims and reducing the number of claims by half to provide clarification and ease of administration. In addition, Applicants requested an interview to expedite the process. On April 6, 2006, the Office found Applicants amendments/arguments persuasive and issued a new rejection based on alleged

anticipation by U.S. 6,089,284 to Kaehler et al. ("Kaehler") under 35 U.S.C. § 102(e). Despite various clarifying amendments to the claims to distinguish this application from that of the cited reference, the Office finally rejected the claims on November 29, 2006<sup>1</sup>, maintaining the same rejection. Applicants respectfully submit that the final office did not properly address Applications arguments made in the response filed on September 12, 2006, asserting that the merchant identifier in both claims 28 and 51 that Kaehler fails to teach. Additionally, for the reasons laid out below, the final office action's new arguments with regards to claims 28 and 51 fail as well.

Independent claim 28 recites a transaction processing system comprising a processor to "determine, from said customer/transmitter identifier and merchant identifier, a payment processor." (emphasis added) As set forth below, Kaehler does not anticipate independent claim 28 because Kaehler does not teach the recited transaction processing system.

As stated in the specification, in one embodiment, the recited transaction processing system "provides a much greater degree of convenience to participating customers since it allows them to preassign specific payment methods to specific retail establishments and to have the preassigned payment methods automatically selected by the transaction processing system whenever the customer utilizes his/her wireless customer transceiver in the merchant's retail establishment." See 09/505721, 6:17-22. "When the customer enters data in the customer transaction database 100, he/she may select any one of the merchant's accepted payment methods in which he/she also has accounts." See 09/505721, 36:1-3. "Customers may also identify a default payment method to be applied to a participating merchant for which no other payment method has been identified. This default payment method would also be applied to new merchants that join the transaction processing system 26 after the customer enrolled." See 09/505721 36:21-37:2. "If ... the system finds the merchant's name, it identifies the customer's payment method for that particular merchant ... and determines the flow and destination of the authorization data, based on the type of transaction (credit, debit, cash, etc.) See 09/505721 40:8-10. "The processor receives the authorization request and transmits it to the payment

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<sup>1</sup> The Office Action mailed on November 29, 2006 was mailed to the wrong address. Applicants did not receive notice of mailing until December 4, 2006. The office action was re-mailed May 2, 2007 and the period was restarted.

processing system dictated by the customer's payment choice for the transaction." See 09/505721, 12:15-17 (emphasis added). Thus, the customer can select different payment options for different merchants (*e.g.*, as claimed in claim 59). This feature is neither disclosed in, nor suggested by, Kaehler. Kaehler does not teach or suggest a transaction processing system that determines a payment processor from a customer identifier and merchant identifier.

Instead, in Kaehler, the customer directly communicates the form of payment to the point of sale device during the transaction. "The information to be authorized is generally financial account information and can either be transmitted with the transponder ID or stored at the central control system 50 or the host network 94 in association with the transponder ID." See Kaehler, 12:36-40. A host network or central control system that associates account information with a transponder ID only, to effect payment, is not a transaction processing system that "determine[s], from said customer/transmitter identifier and merchant identifier, a payment processor."

Moreover, the portions of Kaehler that the Office Action relies upon as teaching the recited transaction processor do not teach or suggest the existence of a merchant ID in any way. For example, column 13, lines 36-49 at best teaches associating an order with a transponder ID to effect payment. In that portion, there is no mention of a merchant ID. Column 11, lines 1-14 at best teach a *dedicated* network or authorization interface, but does not mention a merchant identifier. Finally, column 8, lines 58-67 to column 9, lines 1-18 at best teaches a communications controller for a transponder and does not mention a merchant identifier. Because the relied-upon portions do not teach or suggest the existence of a merchant identifier, it follows that the relied-upon portions do not teach or suggest a transaction processing system that determines a payment processor from a merchant identifier, much less a transaction processing system that "determine[s], from said customer/transmitter identifier and merchant identifier, a payment processor."

In view of the above, it is respectfully submitted that Kaehler does not anticipate or make obvious claim 28. Applicants therefore respectfully submit that claim 28 is allowable over Kaehler.

Claim 51 contains similar recitations as claim 28 and is allowable over Kaehler for at least the reasons discussed above with respect to claim 28. Specifically, claim 51 recites "selecting a payment processor at the transaction processor based at least in part upon information associated with the customer identification data and the merchant identifier stored in

a database accessible by the transaction processor” Because Kaehler does not teach or suggest selecting a payment processor based on information associated with the merchant identifier, Kaehler does not anticipate claim 51. Applicants therefore respectfully submit that claim 51 is allowable over Kaehler.

Claims 31-59, 63-65 and 83-84 depend from allowable claims 28 or 51 and are therefore allowable for at least that reason. These dependent claims are also allowable for at least the additional reasons as stated in the Applicant’s response submitted September 12, 2006.

Therefore, because Kaehler fails to teach each and every claimed limitation as required by section 102, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by ExxonMobil Corporation when the grounds is so clearly improper.

Respectfully submitted,

**HUNTON & WILLIAMS LLP**

Dated: Aug. 2, 2007

By: \_\_\_\_\_

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